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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,323	07/31/2000	James F. Allsup	7554	4709

1688 7590 11/27/2002

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EXAMINER

CHANCE, JANET D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,323

Applicant(s)

ALLSUP, JAMES F.

Examiner

Janet D. Chance

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 31 July 2000. Claims 1-16 are pending. The IDS statement filed 18 December 2000 has been entered and considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: element 80 in Figure 11, and element 112 in Figure 12. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Requirement for Information Under 37 C.F.R. §1.105

3. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. The information is required to identify publications embodying the disclosed subject matter of Long-term disability recovery service with post award service and savings program and financial assistance. The Examiner, upon conducting a search for prior art, discovered an archive of the allsupinc.com web site as listed below.

<http://webarchive.org/web/19991128152241/http://allsupinc.com/index.html>

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<http://webarchive.org/web/2000229231516/www.allsupinc.com/services/corpser.htm>

This archive shows a November 1999, and a February 2000 version of pages of the allsupinc.com web site. These pages describe offering assistance with obtaining Social Security Disability Insurance benefits since 1984, offering loan services, offering assistance in recovering disability costs for insurers and identifying Medicare entitled employees, enrolling those employees, and recovering those costs since 1993.

In response to this requirement, please provide documentation indicating how this web site relates to the instant invention. If it is related, please provide what was disclosed regarding the method of recovery of funds, and what other services were offered since 1984 and 1993. Moreover, please provide any known publications, brochures, product reviews or analyses regarding the products, services or the Allsupinc.com web site or any known publications such as presentations or white papers authored by the inventors that describe the Allsupinc.com web site or its underlying products and services since 1984.

(A) The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

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(B) This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 3-7, 10, 12-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed toward non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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In this case, claims 1, 3-7 and 12-15 only recite an abstract idea. The recited steps of determining if qualified, filing a claim, obtaining an award, and recovering monies do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to obtain Social Security disability benefits.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention of a method of obtaining Social Security disability benefits and recovering overpayment provides valuable services to involved parties.

Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1,3-7, and 12-15 are deemed to be directed to non-statutory subject matter.

(B) Further, under the statute, the claimed invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter. However claim 10 does not seem to fall within one of these recognized categories. It is not directed to a process, as there are no method steps; it is not directed to a system, as there are no system components; it is not directed to a composition of matter, as there are not chemical compounds; and it is not directed toward an article of manufacture, as there is no article. Computer programs not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. In particular, it is unclear whether the computer

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program, as recited in claim 10, is embodied on a specific computer readable medium within the technological arts, since it appears the computer program is not limited to any particular product member. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer's program to be realized (see MPEP section 2106 section IV, B, 1, (a) for further guidance). Simply stated, how is the claimed computer program tangibly embodied within the article of manufacture and how is that embodiment related to a computer to enacts its functions?

(C) The above deficiencies can be overcome by simply expressly stating the employment of the technological arts, such as a processor or digital network for claims 1, 3-7 and 12-15, and a computer readable medium on which the computer program is embodied for claim 10.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Social Security Disability Consultants (SSDC) (29 October 1993).

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(A) As per claim 1, SSDC teaches a method of obtaining Social Security disability insurance benefits (SSDI) from the Social Security Administration (SSA) for a disabled individual, recovering overpaid benefits, and providing services after award comprising:

a) determining if the disabled individual qualifies (SSDC; pg. 2, col. 3, line 9).

b) filing a claim with the SSA for SSDI on behalf of the individual (SSDC; pg. 2, col. 2, line 11-12).

c) obtaining an award of SSDI for the individual as a result of filing (SSDC; pg. 2, col. 1, lines 10-14).

d) recovering disability benefits previously provided to the disabled person by a third party after the award of SSDI and receipt of payments (SSDC; pg. 2, col. 2, lines 27-28). As per the recitation of the recovering the benefits from a deposit account, SSDC teaches the recovery coordination. However it is unclear from what type of account the recovery is withdrawn. It is common practice to withdraw funds from either a deposit or checking account especially in on-line banking or pre-arranged automatic fund withdraw such as with utility or mortgage companies. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to use a deposit account with the motivation of convenience of the disabled individual and reducing delays in payment.

(B) Claim 12 differs from claim 1 with the recitations below:

c-i) determining if the claimant qualifies for a recovery of an overpayment of disability payments, obtaining access to an account, obtaining direct deposit of benefits to the account,

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calculating overpayment, accessing the account, recovering the overpayment amount and returning the overpayment to the third party. SSDC teaches the providing of loss control services and coordination of recovery of overpayments (SSDC; pg. 2, col. 2, lines 27-28 and pg. 2, col. 1, lines 4-5). Each step of the loss control services and coordination of recovery of overpayments is not clear in SSDC. However, in order to provide loss control services and to coordinate the recovery of funds, each of those steps is required. It is logical to include the determining if the claimant is qualified, obtaining access to an account, establishing direct payment to the account, calculating overpayment amount, recovering the overpayment from the account, and returning the overpayment to the third party in the loss control services provided by SSDC. Therefore, the services provided by SSDC read on this limitation, or in the alternative, it would be obvious to include them with the motivation of improving the quality and scope of the services to improve the success of the program (SSDC; pg. 2, col. 1, lines 14-15).

(C) As per claim 13, SSDC teaches the overpayment recovery as rejected in claim 12.

However, SSDC does not expressly disclose the deducting of applicable fees from the overpayment. It is common practice to deduct fees for services. For example, a coin counting machine takes in all the monies and provides a check for the total minus the counting fee, a credit card companies send the merchant the retail cost of the goods minus the service charge. Therefore, it would have been obvious to deduct the applicable fees from the recovery amount with the motivation of obtaining payment for services rendered and maintaining profitability.

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(D) As per claim 14, SSDC teaches the provision of ancillary medical service (SSDC; pg. 2, col. 2, lines 37-40).

8. Claims 2-9, 11 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Social Security Disability Consultants (SSDC) (29 October 1993) as applied to claim 1 and 12 above, and in further view of Cummings, Jr. (5,301,105).

(A) As per claim 2, SSDC teaches recovery of overpayment (SSDC; pg. 2, col. 2, lines 27-28). However, the manner of the recovery of overpayments is unclear in SSDC. Cummings teaches the use of electronic fund transfer (Cummings; col. 14, lines 54-57). It would be obvious to one of ordinary skill in the art at the time of the invention to add the electronic fund transfer of Cummings to the SSDI recovery of SSDC with the motivation of expediting the recovery payments, and as suggested by SSDC improving the quality and scope of services (SSDC; pg. 2, col. 1, lines 14-15).

(B) As per claim 3-6, SSDC teaches providing Social Security assistance programs, training seminars, tracking future eligibility and providing medical, vocational and technical support including Medicare entitlement claims and appeals (SSDC; pg. 2, col. 2, lines 30-40). However, it is unclear in SSDC whether the services are offered prior, during, or after recovery of overpayment. Cummings teaches provision of ancillary services after the transaction completion (Cummings; Figures 10-11 and col. 13, line 40 to col. 14, line 40). It would be obvious to add the timing of the ancillary services of after the recovery of Cummings with the ancillary financial

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services of CCDS with the motivation of providing services when the client has the funds to purchase the services and improving the quality and scope of the services (SSDC; pg. 2, col. 1, lines 14-15).

(C) As per claim 7, SSDC teaches medical support (SSDC; pg. 2, col. 2, lines 37-38).

However, it is unclear if the medical support of SSDC includes prescription drug services.

Cummings teaches the offering of ancillary services of drug prescription (Cummings; Figures 10-11, col. 6, lines 29-36). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to include the prescription service of Cummings in the medical support offered by SSDC with the motivation of improvement in the quality and scope of services (SSDC; pg. 2, col. 1, lines 14-15).

(D) Claim 8 differs from claims 1-2 in the recitation of wherein the electronic capture is "completed before the predetermined amount is removed from the deposit account by the disabled individual". SSDC teaches the coordination of overpayment recoveries as cited in the rejection of claim 1. Included in the coordination, is withdraw of funds while enough funds are in the account, otherwise the recovery effort will be unfruitful. Therefore, the coordination of overpayment recoveries includes completing the capture before the predetermined amount is removed.

(E) As per claim 9, SSDC teaches obtaining a disability award from the SSA (SSDC; pg. 2, col. 2, lines 27-28). However, it is unclear in SSDC the manner in which the funds are

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transferred. Cummings teaches electronic funds transfer (Cummings; col. 14, lines 54-57). It would be obvious to include the electronic funds transfer of Pritchard in the method for obtaining Social Security disability benefits of SSDC with the same motivation provided for claim 2 and incorporated herein.

(F) As per claim 11, SSDC teaches a method for managing a disability insurance overpayment service, including the functions of determining if the individual qualifies, filing a claim with SSA, monitoring the progress of the claim, receiving an award for the claim, providing loss control services including recovering overpayments (SSDC; pg. 2, col. 2, lines 1-40 and pg. 2, col. 1, lines 4-5). However, SSDC does not expressly teach a computer processor, or the manner of the recovery of funds. Cummings teaches a processor (10)(Cummings; Figure 1), and fund transfer (Cummings; col. 14, lines 54-57). It would be obvious to one of ordinary skill in the art at the time of the invention to add the features of Cummings to the method steps of obtaining Social Security disability benefits of SSDC with the motivation of improvement of the quality and scope of services (SSDC; pg. 2, col. 1, lines 14-15).

As per the recitation of calculating an overpayment, SSDC provides loss control services including recovery of overpayment. In order to provide those services and the recovery of funds, the quantity of the recovery amount must be calculated. It is logical to include the calculation of the recovery amount in the loss control services provided by SSDC. Therefore, the services provided by SSDC read on this limitation, or in the alternative, it would be obvious to include them with the motivation of improving the quality and scope of the services (SSDC; pg. 2, col. 1, lines 14-15).

(G) Claim 15 differs from claim 3 in the recitation of “after obtaining payment of SSDI from the SSA to the deposit account” whereas claim 3 recites after recovering the predetermined amount of overpayment. As the combination of the art of SSDC and Cummings have shown the provision of services after the recovery to be obvious in view of the prior art, it is logical that the providing of services after the award of the SSDI would be obvious as well since the award happened prior to recovery. Therefore the rejection of claim 3 addresses the limitations of this claim as well and is incorporated herein.

(H) Claim 16 recites the same limitations as claim 2, and is therefore rejected for the same reasons provided for that claim and incorporated herein.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Social Security Disability Consultants (SSDC) (29 October 1993), and in further view of Pritchard. (4,491,725).

(A) As per claim 10, SSDC teaches a post-disability products and services (SSDC; pg. 2, col. 2, lines 27-40). However SSDC does not expressly teach computer software that gathers, integrates and utilized data from a plurality of unrelated federal forms to populate databases. Pritchard teaches software that gathers, integrates and utilized data from a plurality of unrelated forms to populate databases (Pritchard; col. 1, lines 59-66, col. 7, lines 40-46, and col. 3, lines 30-40). It would be obvious to none of ordinary skill in the art at the time of the invention to add the computer software gathering and integrating feature of Pritchard with the Disability

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recovery method of SSDC with the motivation suggested by Pritchard of making information regarding services available (Pritchard; col. 1, line 51-53).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not relied upon art teaches a medical payment system including filing claims for disability, providing additional services, and fund transfer (4,858, 121), a third party financial management vehicle for the healthcare industry that includes a patient account from which fund are drawn, fees are subtracted from funds and the offering of drug prescription programs (6,208,973 B1), an article about overpayment to workers in a workers compensation claim (Anonymous "Injured Workers Were Paid Too Much), an article about unemployment insurance legislation that details that Kentucky, Maryland and Missouri joined the interstate agreement that allow each state to recover overpayment of unemployment benefits (Runner, Diana, "Changes in unemployment insurance legislation during 1988", accession no. 03897677, file 148), an archived web site from 1999 and early 2000 that details Social Security Disability services offered since 1984 and 1993 (<http://webarchive.org/web/19991128152241/http://allsupinc.com/index.html> ; <http://webarchive.org/web/2000229231516/www.allsupinc.com/services/corpser.htm>), and an article about disability management detailing that best in class disability risk management programs include other income such as Social Security, overpayment recovery, eligibility verification (King, Drew, "Know The Disability Management Benchmarks").

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11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 305-7687 [Official communications]

(703) 746-7238 [After Final communications, labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.

**12. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Janet D. Chance whose telephone number is (703) 305-5356.**


The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the
organization where this application or proceeding is assigned are (703) 746-7687 for regular
communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 308-1113.

JDC

November 22, 2002


DINH X. NGUYEN
PRIMARY EXAMINER